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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,264	11/19/2003	Palanisamy Arjunan	2002B171/2	7729

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EXAMINER

RABAGO, ROBERTO

ART UNIT PAPER NUMBER

1713

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/717,264	ARJUNAN, PALANISAMY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Roberto Rábago	1713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/19/2003</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of group II, claims 38-61, in the reply filed on 5/3/06 is acknowledged. The traversal is on the ground(s) that the restriction is improper because it will lead to duplicative searching and prosecution. This is not found persuasive because the two inventions are distinct, for the reasons previously stated; accordingly, each invention requires a separate, non-overlapping search, and prior art applicable to one group of claims would not be applicable to the other.

The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 38, 40-42, 44-53, and 55-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Gotoh (US 4,987,193).

The reference discloses a composition comprising a branched crystalline diene-modified random propylene polymer. Example 1 describes random polymerization of propylene and 7-methyl-1,6-octadiene resulting in a polymer comprising 3.9 mol%

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diene, with MFR of 3.1 g/10 min and DSC  $T_m$  of 150°C. Example 2 is analogous, resulting in a polymer comprising 2.6 mol% diene, with MFR of 3.5 g/10 min and DSC  $T_m$  of 152.3°C. Although the examples have not included a second diene, one of ordinary skill in the art would immediately envisage a polymer analogous to those of the working examples which also includes 6-methyl-1,6-octadiene because patentee has repeatedly stressed that a mixture of these two dienes may be used in the method (abstract; col. 2, line 14; col. 2, line 34; col. 4, line 38-41; col. 4, line 53-54; col. 6, line 33-35). The reference has not reported heat of fusion or crystallization temperature; however, the claimed values would be inherent in polymers of the type shown in examples 1 and 2 (and analogous polymers including both dienes) because a  $T_m$  of 150°C or more is consistent with a heat of fusion and crystallization temperature within the claimed range. The burden of proof is shifted to applicant to show that the polymers made by the reference methods would not have the unreported claimed properties.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 39, 43, 54 rejected under 35 U.S.C. 103(a) as being unpatentable over Gotoh (US 4,987,193).

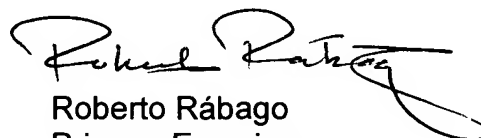
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The parent claims are discussed with respect to this reference above. Missing from the previously cited examples is the use of the claimed monomer ratios and an example with the claimed  $T_m$ . However, one of ordinary skill in the art would be motivated to use the claimed diene proportions because the reference suggests at col. 7, fourth paragraph, ranges up to 6% or up to 10% of diene monomers. Polymer having  $T_m$  of 160°C is suggested at col. 8, line 13.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Roberto Rábago  
Primary Examiner  
Art Unit 1713

RR  
July 7, 2006